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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/521,713

01/19/2005

Marc Berenguer

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12/29/2005

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EXAMINER

CHAN, WING F

ART UNIT

PAPER NUMBER

2643

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/521,713	BERENGUER, MARC	
	Examiner	Art Unit	
	Wing F. Chan	2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 7, 11-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishida et al (EP 0 622 969 hereinafter Ishida).

As to claims 1, 7, 11-14, Ishida discloses a videophone station and method for conversation as claimed comprising speaker 28, microphone 30 (oral telecommunication means), components 18, 19, 20 reads on the claimed digital processing unit for processing video data, a generally vertical first screen 6, image capture means 7, a second screen 103 arranged at the foot of the first screen and oriented on an inclined plane (see Fig. 25) and displaying data relative to the distant

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person (e.g. the log information, system operation), the system controller also provides overall control and to drive the digital processing unit.

As to claim 2, see Fig. 25 where the screens are flat.

As to claim 3, note that Ishida discloses the use of a camera, and the videophone station is connected over an ISDN and the phone number or subaddress of the videophone station is a unique network address. See Ishida col. 26 lines 21-31 for example.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida in view of Cortjens et al (US PAT. NO. 5,598,209 hereinafter Cortjens).

Ishida differs from the claimed invention in not disclosing the control means comprise at least one of a mouse or joystick, and is operable to control the camera associated with the distant person.

However, it is old and well known in the art for a videophone station to comprise at least one of a mouse or joystick, and is operable to control the camera associated with the distant person, for example see Cortjens' abstract, col. 4 lines 4-54, to properly center the distant person. Thus, it would have been obvious to one of ordinary skill in

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the art at the time the invention was made to modify Ishida to comprise at least one of a mouse or joystick, and is operable to control the camera associated with the distant person to properly center and focus on the distant person during conversation.

6. Claims 5, 8, 15-17, 19, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida in view of Ludwig et al (EP 0 898 424 hereinafter Ludwig).

As to claim 5, Ishida differs from the claimed invention in not disclosing the videophone station is connected to a local area network.

However, it is old and well known in the art for a videophone station to be connected to a LAN, for example see Ludwig's abstract, col. 8 line 15 to col. 9 line 27, to make efficient use of existing LAN wirings to enabling sharing of data. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ishida to comprise connection using a LAN.

As to claim 8, Ishida teaches the use of handwriting input device for entering text information as memo, guide messages, etc., and that the conversation is recorded for future references, see col. 22 line 28 to col. 23 line 12. Ludwig also discloses it is well known to provide telepointing and annotation capabilities in videophone stations, and the conversation is recorded and stored for later playback, e.g. see col. 3 lines 23-31. Ishida as modified by Ludwig differs from the claimed invention in not disclosing the use of a keyboard for entering text, however it is common knowledge that text can be enter using a keyboard or a handwriting device, thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ishida as modified

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by Ludwig to use a keyboard device for entering text since the two are well known substitutes for each other. Furthermore, with the use of keyboard the text is always legible while handwriting may not always be legible; and a handwriting recognition software is not needed thus reducing the cost of the system.

As to claims 15, 17, note directory server 66 in Ludwig.

As to claims 16, 19, 20, Ludwig discloses connecting via LAN including a gateway 40, for example see Figs. 3, 4.

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida as modified by Ludwig as applied to claim 16 above, and further in view of Cortjens et al (US PAT. NO. 5,598,209 hereinafter Cortjens).

Ishida as modified by Ludwig differs from the claimed invention in not disclosing the control means comprise at least one of a mouse or joystick, and is operable to control the camera associated with the distant person.

However, it is old and well known in the art for a videophone station to comprise at least one of a mouse or joystick, and is operable to control the camera associated with the distant person, for example see Cortjens' abstract, col. 4 lines 4-54, to properly center the distant person. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ishida as modified by Ludwig to comprise at least one of a mouse or joystick, and is operable to control the camera associated with the distant person to properly center and focus on the distant person during conversation.

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8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida in view of Arnott (US PG PUB. NO. 2002/0083462).

Ishida discloses connection means being an ISDN, but Ishida differs from the claimed invention in not disclosing the videophone station is connected via ADSL.

However, it is old and well known in the art to use ADSL lines as an alternative to ISDN since ADSL "allow more data to be sent over existing copper telephone lines at greater speeds" and "transmission of both voice and data" (e.g. see Arnott paragraph [0028]). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ishida to connect to an ADSL telephone link to "allow more data to be sent over existing copper telephone lines at greater speeds" and "transmission of both voice and data".

9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida.

As to claim 9, Ishida in Fig. 25 shows a work table and the display screens are angled with respect to a horizontal plane. Ishida discloses the claimed invention except for specific angle with respect to a horizontal plane. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ishida to have the claimed angles, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

As to claim 10, Ishida teaches the camera is located above the first screen. Ishida also teaches placing the camera to the side of the screen such as in Fig. 2,

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clearly suggesting the camera can be located anywhere around the display. Ishida discloses the claimed invention except for camera being below the first screen. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ishida to place the camera below the first screen, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

10. Claims 16, 19, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida in view of Tucker et al (US PAT. NO. 6,590,604 filed April 7, 2000 hereinafter Tucker).

Ishida differs from the claimed invention in not disclosing a LAN including a gateway.

However, it is old and well known in the art for videophone station systems to be connected to a LAN including a gateway for establishing connections to remote videophone stations via WAN (e.g. ISDN, Internet), for example see Tucker Fig. 7, col. 9 line 40 to col. 10 line 19. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ishida to comprise a LAN including a gateway for establishing connections to remote videophone stations via WAN (e.g. ISDN, Internet).

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11. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida as modified by Tucker as applied to claim 16 above, and further in view of Cortjens et al (US PAT. NO. 5,598,209 hereinafter Cortjens).

Ishida as modified by Tucker differs from the claimed invention in not disclosing the control means comprise at least one of a mouse or joystick, and is operable to control the camera associated with the distant person.

However, it is old and well known in the art for a videophone station to comprise at least one of a mouse or joystick, and is operable to control the camera associated with the distant person, for example see Cortjens' abstract, col. 4 lines 4-54, to properly center the distant person. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ishida as modified by Tucker to comprise at least one of a mouse or joystick, and is operable to control the camera associated with the distant person to properly center and focus on the distant person during conversation.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wing F. Chan whose telephone number is 571-272-7493. The examiner can normally be reached on Monday to Friday from 9 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on 571-272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Wing F. Chan
Primary Examiner
Art Unit 2643

12/23/05